

### REMARKS

The present application is a Rule 114 Request for Continued Examination (RCE) of application Serial No. 09/864,959, filed May 24, 2001.

In an amendment after final filed September 15, 2006, applicants presented arguments traversing the prior art rejection of claims 29-34 under 35 U.S.C. §102(e) as being anticipated by Mankoff (US 2003/0028518). In an Advisory Action dated September 27, 2006, the Examiner advised that the request for reconsideration does not overcome the prior art rejection of the claims set forth in the final Office Action.

By the present RCE, new claims 35-38 have been added to provide a fuller scope of coverage.

Applicants respectfully submit that the prior art of record does not disclose or suggest the subject matter recited in claims 29-34 and newly added claims 35-38. Applicants therefore request reconsideration of their application as set forth below.

#### Claims 29-34

Applicants' arguments for claims 29-34 presented in the September 15 amendment after final are incorporated herein by reference in their entirety.

Additionally, on page 2 of the September 27 Advisory Action, the Examiner contends that the features of the credit card settlement system recited in claims 29-34 are disclosed in provisional application Nos. 60/142,611 ("the '611 provisional application) and 60/191,352 ("the '352 provisional application) which have been incorporated by reference in the Mankoff disclosure via U.S. patent application Serial No. 10/081,257 ("the '257 parent application") and U.S. Patent Application Serial No. 09/611,672 ("the '672 parent application"). Applicants respectfully disagree with the Examiner's contentions.

#### **The '257 and 672 Parent Applications**

The cited reference to Mankoff, which has a filing date of October 1, 2002, claims priority to and is a continuation-in-part of the '257 parent application", which has a filing date of February 22, 2002, and the '672 parent application", which has a filing date of July 7, 2000.

While Mankoff discloses a system having components similar to those of the systems recited in claims 29-34, such system components are not disclosed in either of the '257 and '672 parent applications. Instead, the '257 parent application relates to a system in which virtual documents are received using an interface with an interactive television

system, and in which the received virtual documents are transferred to a smart card. Likewise, the '672 parent application relates to a system in which virtual documents are associated with attribute files and stored in a database. These systems are different from and do not include the systems components recited in claims 29-34.

Thus, since Mankoff is a continuation-in-part of the '257 and '672 parent applications, and since the parent applications do not disclose a system having components similar to those of the systems recited in claims 29-34, the effective filing date of Mankoff for the system components similar to those of the systems recited in claims 29-34 is October 1, 2002, based upon the filing date of the Mankoff application. This date is later than applicants' U.S. filing date of May 24, 2001, and further much later than the effective filing date of May 25, 2000 to which applicants' application would be entitled to upon perfecting their claim for priority under 35 U.S.C. §119, thereby making Mankoff ineffective as a reference.

#### **The '611 Provisional Application**

The structural and functional combinations of the credit card settlement systems recited in claims 29-34 is also not disclosed or suggested by the '611 provisional application.

The '611 provisional application discloses an online coupon system. This system involves the use of a Voupon.com credit card which has a Voupon redemption number stored on it. The electronic coupon is associated with the redemption number which could be stored in a magnetic strip of the Voupon.com card, or the Voupon.com card could be a smart card (pg. 11, sections 1.1-1.4).

In contrast, independent claim 29 recites electronic coupon registration means for registering electronic coupons associated with identification information on a credit card. Likewise, independent claim 33 recites an electronic coupon server for storing information on electronic coupons associated with the identification information on the credit card. Stated otherwise, in the system of the '611 provisional application the electronic coupon is not stored and associated with credit card identification information, as recited in claims 29 and 33. Instead, the system of the '611 provisional application requires the use of a redemption number which is provided to the credit card by the Voupon.com affiliate credit card company in addition to the credit card identification information. Thus credit cards not having the redemption number, such as commonly used credit cards, cannot be used in the system of the '611 provisional application. In contrast, in the credit card settlement system recited in claims 29 and 33, any commonly used credit card can be used.

The system of the '611 provisional application also does not disclose or suggest the license request transmission means and corresponding function recited in independent claims 29 and 33.

More specifically, the '611 provisional application discloses that a user discount is applied by transmitting the discount back to a POS terminal through a visa protocol machine (pg. 12, sections 1.7-1.8). However, the '611 provisional application does not disclose or suggest any means for executing a credit card settlement reflecting the discount information. In the system of the '611 provisional application, the transaction of the credit card settlement is completed before the price is discounted. Stated otherwise, the credit card settlement in the system of the '611 provisional application does not reflect the discount information.

In contrast, independent claim 29 recites license request transmission means for transmitting to a credit card settlement center a license request for the credit card settlement reflecting the price discounted by the discount means. Thus, unlike the system of the '611 provisional application, in the credit card settlement system recited in claim 29 the discount information is not transmitted to a POS terminal. Instead, the discount information is used in the

credit card terminal to recreate credit card settlement information reflecting the discount information for the license request.

In addition to reciting means for executing a credit card settlement reflecting the discount information, independent claim 33 further recites specific means and corresponding functions directed to the discount process by the credit card terminal, which is not disclosed or suggested by the '611 provisional application.

#### **The '352 Provisional Application**

The '352 provisional application discloses a system in which virtual documents attached to e-mail are automatically stored and associated with the personal information and the user can use the virtual documents when needed. However, the '353 provisional application clearly does not disclose or suggest the specific structural and functional combinations of the credit card settlement systems recited in independent claims 29 and 33.

In summary, the '611 and '352 provisional applications do not disclose or suggest all of the components of the credit card settlement systems recited in independent claims 29 and 33. Accordingly, the effective filing date of Mankoff for the system components similar to those of the

systems recited in claims 29-34 is October 1, 2002, based upon the filing date of the Mankoff application. This date is later than applicants' U.S. filing date of May 24, 2001, and further much later than the effective filing date of May 25, 2000 to which applicants' application would be entitled to upon perfecting their claim for priority under 35 U.S.C. §119, thereby making Mankoff ineffective as a reference.

#### Improper Incorporation by Reference

In addition to the foregoing, applicants respectfully submit that the incorporation in the '672 parent application of at least the '611 provisional application is improper.

In order to incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the document from which the material is incorporated by reference. Advanced Display Sys., Inc. v. Kent State Univ., 54 USPQ2D 1673, 1680 (Fed. Cir. 2000). This requirement is also set forth in MPEP §608.01(p). Mere reference to another application is not an incorporation of anything. In re Seversky, 177 USPQ 213, 216-217 (CCPA 1971).

In this case, the '672 parent application merely makes a statement that the '611 provisional application is incorporated by reference, but does not identify with detailed particularity what specific material it incorporates and does not clearly indicate where that material is found in the '611 provisional application. This is evident from the fact that the '672 parent application does not address at all any of the system components disclosed in the '611 provisional application corresponding to the system components disclosed in Mankoff. Again, the '672 parent application relates to a system in which virtual documents are associated with attribute files and stored in a database. This system is different and does not include the system component disclosed in the '611 provisional application.

Thus, because the incorporation by reference of the '611 provisional application in the '672 parent application is improper, the disclosure of the '611 provisional application does not form part of the disclosure in the '672 parent application. Accordingly, the disclosure relating to the credit card settlement system in the '611 provisional application does not carry over to the family applications filed after the '672 parent application, including the Mankoff publication applied by the Examiner against claims 29-33.



Accordingly, the effective filing date of Mankoff for the system components similar to those of the systems recited in claims 29-34 is October 1, 2002, based upon the filing date of the Mankoff application. This date is later than applicants' U.S. filing date of May 24, 2001, and further much later than the effective filing date of May 25, 2000 to which applicants' application would be entitled to upon perfecting their claim for priority under 35 U.S.C. §119, thereby making Mankoff ineffective as a reference.

Applicants have thus antedated the cited reference to Mankoff and respectfully submit that the rejection of claims 29-34 under 35 U.S.C. §102(e) is erroneous and should be withdrawn.

#### **New Claims 35-38**

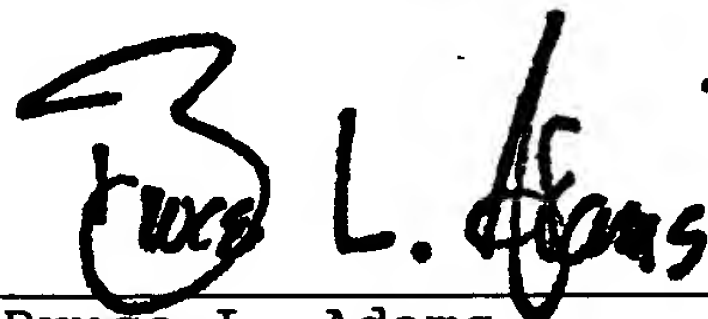
New claims 35-38 depend on and contain all of the limitations of independent claim 29 and, therefore, are patentable over the prior art of record at least for the same reasons set forth above for independent claim 29.

In view of the foregoing amendments and discussion,  
the application is now believed to be in condition for  
allowance. Accordingly, favorable reconsideration and  
allowance of the claims are most respectfully requested.

Respectfully submitted,

ADAMS & WILKS  
Attorneys for Applicants

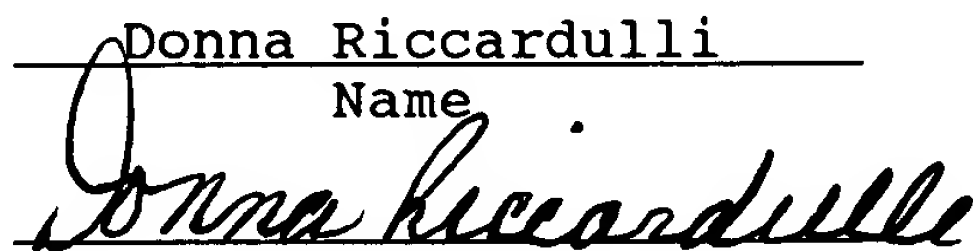
By:

  
Bruce L. Adams  
Reg. No. 25,386

17 Battery Place  
Suite 1231  
New York, NY 10004  
(212) 809-3700

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Donna Riccardulli  
Name  
  
Signature

NOVEMBER 15, 2006  
Date